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### Comments/Special Instructions

Re:

Response to Restriction Requirement U.S. Patent Application No. 10/689,220

Glass as Sintering Aid and Open-Pore Moulded **Body and Method for Manufacturing Same** 

Art Unit: 1755

Examiner: Group, Karl E. Our Docket No.: 3975.024

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{WP276865:1}

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U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE Under the Pancowork Reduction Act of 1995, no persons are required to respond to a collection of information uniters it displays a valid OMB control number Application Number 10/689,220 TRANSMITTAL Filing Date October 20, 2003 FORM First Named Inventor Berger et al. Art Unit (to be used for all correspondence after initial filing) 1755 Examiner Name Group, Karl E. Attomey Docket Number 3975.024 Total Number of Pages In This Submission **ENCLOSURES** (Check all that apply) After Allowance communication Fee Transmittal Form Drawing(s) to Technology Center (TC) Appeal Communication to Board Licensing-related Papers Fee Attached of Appeals and Interferences Appeal Communication to TC Petition Amendment/Reply (Appeal Notice, Brief, Reply Brief) Petition to Convert to a Proprietary Information After Final Provisional Application Power of Attorney, Revocation Affidavits/declaration(s) Status Letter Change of Correspondence Address Other Enclosure(s) (please Terminal Disclaimer **Extension of Time Request** Identify below): Response to Restriction Requirement Request for Refund Express Abandonment Request CD, Number of CD(s) Information Disclosure Statement Remarks Certified Capy of Priority Document(s) Response to Missing Parts/ Incomplete Application Response to Missing Parts under 37 CFR 1.52 or 1.53 SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT Firm Stephan A. Pendori/Akerman Senterfitt/Reg. No. 32,665 P.O. Fo.) 3188 Individual name Palm Bea West Signature Date January 6, **2**006 CERTIFICATE OF TRANSMISSION/MAILING I hereby certify that this correspondence is being facsimile transmitted to the USPTO or deposited with the United States Postal Service with sufficient postage as first class mail in an envelope addressed to: Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450 on the date shown below. Typed or printed name Stephan A. Pendorf, Reg/No. *22*1665 Date Signature Jenuary 6, 2006 This collection of information is required by 37 CFR 1.5. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.14. This collection is estimated to 2 hours to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450, DO NOT SEND FEES OR COMPLETED FORMS TO THIS

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SERIAL NO .:

10/689,220

CONFIRMATION NO.:

4079

APPLICANT:

Berger et al.

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FILED:

October 20, 2003

JAN 0 6 2006

GROUP ART UNIT:

1755

EXAMINER:

Group, Karl E.

ATTORNEY DOCKET

3975.024

NO.:

CUSTOMER NO.:

30448

FOR:

Glass as Sintering Aid and Open-Pore Moulded Body and Method for

Manufacturing Same

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Commissioner for Patents P.O. Box 1450

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DATE: January 6, 2006

# RESPONSE TO RESTRICTION REQUIREMENT

Sir:

The Examiner issued a restriction requirement on December 6, 2005 in which the Examiner identified

- Group I, claims 1-5, drawn to glass, classified in class 501, subclass 72;
- Group II, claims 6-7, drawn to a method of manufacturing a body, classified in class 264, subclass 603 and

Amendment Dated January 6, 2006

Response To Restriction Requirement Dated December 6, 2005

Group III, claims 8-9, drawn to a body, classified in class 501, subclass 1.

In response to the non-final Office Action (hereinafter "the Action"), Group III (claims 8-9) is elected for prosecution with traverse against the opinion of the Examiner that group II and group III are distinct. Applicants request withdraw the Restriction Requirement for inventions II and III for the following reasons.

The Examiner founded his opinion that the product as claimed may be made by another process, i.e. by hot pressing. This argument is not persuasive because by hot pressing it is necessary to bring an open pore body into a mould, add the slurry on the body and press the hot mould walls against the outer surface of the body. By that action the open pores of the body will be closed through the pressure or stick together. Also, closing will take place by the hot pressed slurry and its solidification between the flat/smooth walls of the mould and the body surface.

In this way a significant part of the pores are not open and the ability for resorption of the body would not be given or dramatically reduced.

Further, as set forth in the specification, paragraph [00012]:

Surprisingly, it has been found that the 2-component variant described above yields the desired sintered product, whereas an immediate combination of all components does not support the sintering process as desired. Unless the separately produced amorphous glass phase is added, no solid structure is achieved by applying the TCP slurry onto a polyurethane sponge and sintering it, but parts of the sintered product crumble away.

Thus, the present invention is made based on the recognition that keeping the glass component and the β-tricalcium phosphate components separated until a subsequent stage in manufacturing produces a superior product. Where such a product can not be easily claimed in product terms, Applicants are entitled to claim the product in product-by-process claims. Process and product-by-process are two forms for claiming such an invention. And if the product exhibits novel identifiable characteristics, then Applicants should be entitled to claim such a product as well as the unique characterizing process by which it is produced, and the product-by-process.

{WP276858:1}

Response To Restriction Requirement Dated December 6, 2005

Pursuant to MPEP 803, if the search and examination of all the claims in an application can be made without serious burden, the examiner must examine them on the merits, even though they include claims to independent or distinct inventions.

Pursuant to MPEP 802.01, the Director may require restriction if two or more "independent and distinct" inventions are claimed in one application. ... The term "independent" as already pointed out, means not dependent. A large number of inventions between which, prior to the 1952 Act, division had been proper, are dependent inventions, such as, for example, combination and a subcombination thereof; as process and apparatus used in the practice of the process; as composition and the process in which the composition is used; as process and the product made by such process, etc.

The term "independent" (i.e., not dependent) means that there is no disclosed relationship between the two or more inventions claimed, that is, they are unconnected in design, operation, and effect. For example, a process and an apparatus incapable of being used in practicing the process are independent inventions. ... Two or more inventions are related (i.e., not independent) if they are disclosed as connected in at least one of design (e.g., structure or method of manufacture), operation (e.g., function or method of use), or effect. Examples of related inventions include combination and part (subcombination) thereof, process and apparatus for its practice, process and product made, etc....

The present invention being claimed in the form of a process, the product of the process, and a product having the unique morphology directly attriubted to the process by which it is produced, all relating to the the recognition that keeping the glass component and the  $\beta$ -tricalcium phosphate components separated until a subsequent stage in manufacturing produces a superior product. Thus, these claims relate to only a single invention.

Withdrawal of the restriction requirement with respect to Group  $\Pi$  and Group  $\Pi$  is respectfully requested.

No fees are believed due; however, the Commissioner is hereby authorized to charge any deficiency, or credit any overpayment, to Deposit Account No. 50-0951.

(WP276858;1)

Jan-06-06

U.S. Serial No. 10/689,220 Amendment Dated January 6, 2006 Response To Restriction Requirement Dated December 6, 2005

Should the Examiner believe that anything further is necessary, the Examiner is respectfully requested to contact the undersigned representative at the telephone number listed below.

Respectfully submitted

Stephan A. Pendorf Reg. No. 32,665

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